



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,456	01/23/2004	Steven Frisch	AP-225	6754

7590

03/14/2005

Bernard Malina
Malina & Wolson
Suite 501
60 East 42nd Street
New York, NY 10165

EXAMINER

NGUYEN, TRINH T

ART UNIT	PAPER NUMBER
----------	--------------

3644

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,456

Applicant(s)

FRISCH, STEVEN

Examiner

Trinh T Nguyen

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3644

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a glue board, classified in class 43, subclass 114.
 - II. Claim 16, drawn to a method for preparing a glue board, classified in class 43, subclass 115.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as without coating the second substrate with a second adhesive layer.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Attorney Malina on 2/16/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16 has been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "24" has been used to designate both a plastic film or paper layer and a release layers. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3644

8. Claims 3-8, and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3: the language for "a first release coating" and "a second release coating" are confusing since the specification defines as "a first release layer" and "a second release layer". Note the claim 6 has a similar problem.

In claim 7: the language for "a first and second relatively layer edge" is confusing since it is unclear as what is being claimed.

In claim 13: the phrases "said first relatively longer edge", "said second relatively longer edge", and "said relatively longer" lack proper antecedent basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 7, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Thum (US 486,138) (Please see a more detail Figures 1 and 2 of Thum attached with the Office Action for further explanation for claims 1-4, 7, 13, and 15).

For claim 1, Thum discloses a glue board and packaging assembly comprising: a first substrate (f); a first adhesive layer deposited on said first substrate; a release member with said release member overlying said first adhesive layer; a second

Art Unit: 3644

substrate (a); a second adhesive layer with said second adhesive layer in contact with said release member.

For claim 2, Thum discloses said release member comprises a first surface and a second surface with said first surface in contact with said first adhesive layer and with said second surface in contact with said second adhesive layer.

For claim 3, Thum discloses said release member comprises a thin flexible member, a first release coating (e) deposited on said first surface, and a second release coating (c) deposited on said second surface.

For claim 4, Thum discloses said thin flexible member comprises a paper member.

For claim 7, Thum discloses said first substrate and said second substrate each comprise a generally rectangular manner having a first and second relatively layer edge and a first and a second relatively shorter edge.

For claim 13, Thum discloses said first and said second substrates each further comprise: an area adjacent said first relatively longer edge; an area adjacent said second relatively longer edge; an area adjacent said first relatively shorter edge; an area adjacent said second relatively shorter edge with said areas adjacent said relatively longer and said relatively shorter edges free of said adhesive layers.

For claim 15, Thum discloses said release member is generally coextensive

Art Unit: 3644

with said first substrate and said second substrate, and wherein said release member facilitates peeling said first and said second substrates apart.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138).

For claim 5, as described above, Thum discloses most of the claimed invention except for indicating that the thin flexible member comprises a plastic member. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

For claim 6, as described above, Thum discloses most of the claimed invention except for indicating that the first release coating and the second release coating comprise a fluorosilicone release coating. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select such a material, since it has been held to be within the general skill of a worker in the art to select a

Art Unit: 3644

known material on the basis of its suitability for the intended use as a matter of obvious design choice.

13. Claims 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138) in view of Silvey (US 3,025,630).

As described above, Thum discloses most of the claimed invention except for indicating that the first substrate and the second substrate further comprise a plurality of score lines.

Silvey teach a similar assembly as that of Thum in which Silvey's assembly includes the teaching of using score lines so that the assembly can be folded to a desirable shape and/or size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum so as to include the use of score lines, in a similar manner as taught in Silvey, in order to allow the assembly to be folded to a desirable shape and/or size.

For claim 11, Thum as modified by Silvey (emphasis on Silvey) further discloses the first relatively shorter edge comprises a tab portion.

For claim 12, Thum as modified by Silvey (emphasis on Silvey) further discloses the first substrate and the second substrate further comprise a slot formed in the area adjacent to the relatively shorter edge.

14. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138) in view of Palmeri (US 4,385,465).

Art Unit: 3644

Thum lacks the first substrate and the second substrate are made of cardboard and/or paper board.

Palmeri teaches a similar assembly as that of Thum in which Palmer's assembly includes the substrate made out of cardboard and/or paper board. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum so as to include the substrate made out of cardboard and/or paper board, in a similar manner as taught in Palmeri, since it is cheaper to use cardboard and/or paper board.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 486,138) in view of Weil (US 2,328,590).

Thum lacks the first surface and the second surface are provided with indicia.

Weil teaches a similar assembly as that of Thum in which Weil's assembly includes the surfaces are provided with indicia (see Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the assembly of Thum so as to include an indicia on the surfaces of the assembly, in a similar manner as taught in Weil, since to do so would provide some sort of labeling and/or advertising for the assembly.


Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

Art Unit: 3644

The examiner's supervisor, Teri Luu can be reached on (703) 305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



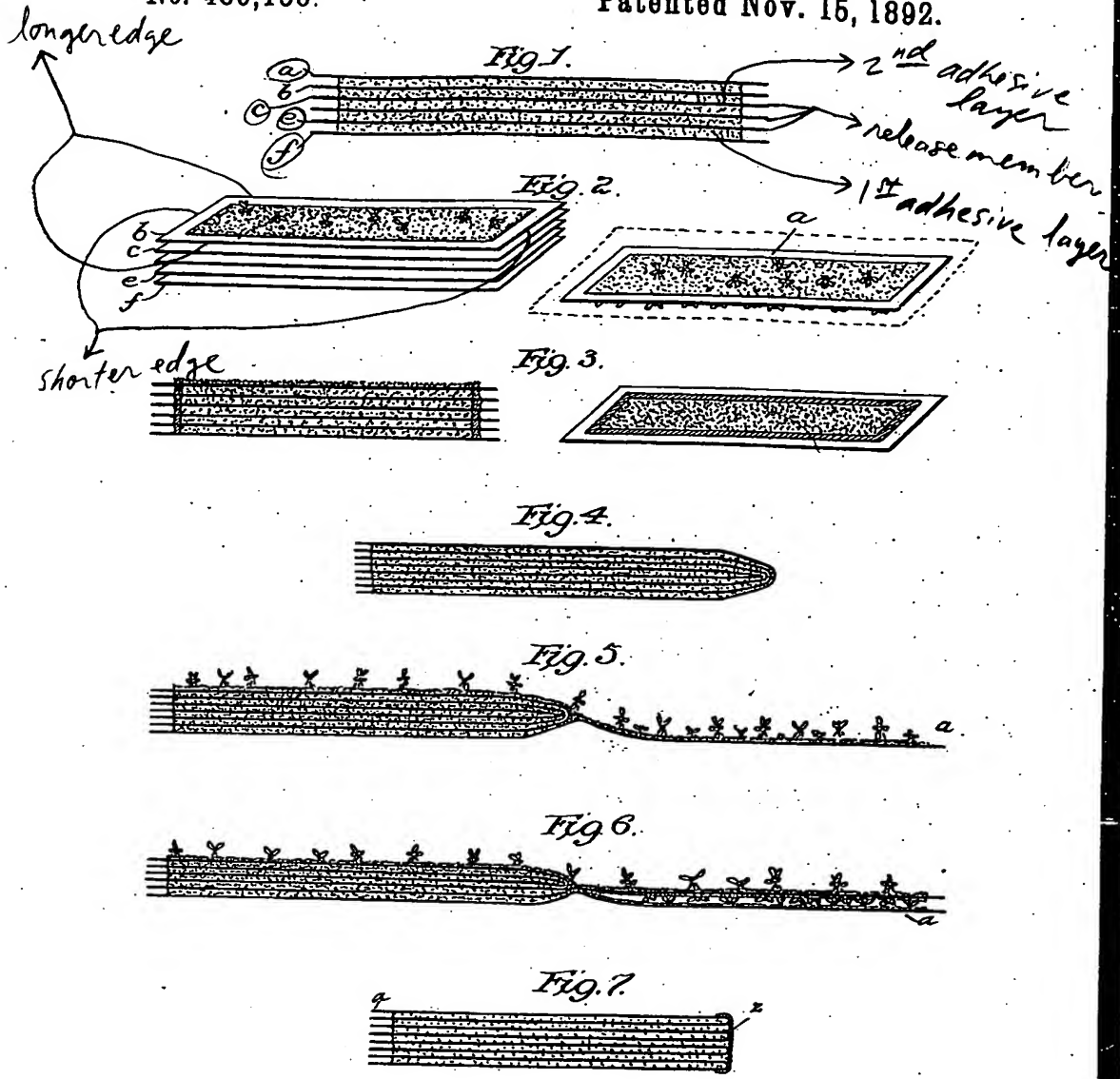
Trinh T Nguyen
Patent Ex.
Art Unit 3644
3/2/05

(No Model.)

O. & W. THUM.
BOOK OF STICKY FLY PAPER.

No. 486,138.

Patented Nov. 15, 1892.



Attest
F. L. Middleton

Inventors
Otto Thum
William Thum
by Ellis Spear
Atty.